UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Carl P. Taussig

Appeal No. 2005-2518
Application No. 09/716,198

ON BRIEF

Before THOMAS, BARRETT, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4-8, and 10-26, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellant's invention relates to an optical disk having zone constant angular velocity wobble. An understanding of the invention can be derived from a reading of exemplary claims 1, 11 and 19, which are reproduced below.

1. An optical storage medium comprising:

a recordable medium; and

a groove in the recordable medium, the groove having a constant angular velocity wobble, wherein wobble cycles of the groove form a plurality of concentric zones and wherein wobble cycles in the same zone are spatially coherent.

11. An optical storage medium comprising:

a recordable medium; and

a groove in the recordable medium, the groove having a plurality of wobble cycles that form a plurality of concentric zones, wobble cycles in the same zone subtending the same angle, wobble cycles in different zones subtending different angles.

19. An optical disk comprising:

a recordable medium; and

a groove in the recordable medium, the groove having a plurality of wobble cycles that form a plurality of concentric zones, wobble cycles in the same zone subtending the same angle, wobble cycles in different zones subtending different angles, the wobble cycles being BPSK-modulated.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Miyamoto et al. (Miyamoto)	5,936,933	Aug. 10, 1999
Kobayashi et al. (Kobayashi)	5,991,257	Nov. 23, 1999[1]
Aoki	5,999,504	Dec. 07, 1999

Claims 1, 4-8, 10, 11 and 13-18 stand rejected under 35 U.S.C. § 102 as being anticipated by Miyamoto. Claims 2, 12, 19 and 20 stand rejected over Miyamoto in view of Aoki.[2]

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the answer (mailed Jun. 2, 2003) and supplemental answer[3] (mailed Nov. 10, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Jan. 22, 2003) for appellant's arguments thereagainst.

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[1] We note that the examiner has not identified Kobayashi in the statement of the grounds of rejection, but mentions the reference in the body of the rejection. We assume the examiner merely relies upon the reference to define a Z-CAV since the examiner has provided no reasons for the combination in the statement of the rejection.

[2] We find no rejection of newly added dependent claims 21- 26, but assume that the examiner would have included them in the corresponding rejection with the base claim and we will treat them as standing or falling with their base claim since neither the examiner nor appellant has presented separate arguments thereto.

[3] We will refer to the supplemental answer as the examiner's statement of the grounds for the rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. **Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Appellant argues that Miyamoto does not teach any sort of phase relationship between wobble cycles, let alone wobble cycles that are spatially coherent. (Brief at page 5.) Appellant argues that Miyamoto is silent about the spatial relationship of wobble cycles on different tracks. (Brief at page 5.) We agree with appellant that Miyamoto does not expressly discuss the spatial relationship, and we cannot discern any relationship from the figures. The examiner maintains that it is his interpretation that Miyamoto's "description as defining that of a zonal CAV. Zonal CAV is further defined as found in Kobayashi et al." (Answer at page 3.) While the examiner may interpret Miyamoto in this manner, we find no express teaching thereof and do not find that this structure is "inherent." The examiner then addresses the claim language and identifies columns 2, 4, 5, and 22 as teaching "wherein wobble cycles of the groove form a plurality of concentric zones and wherein wobble cycles in the same zone are spatially coherent." We find no such express teaching in Miyamoto and cannot discern from the figures if such a spatial relationship exists or would have been inherent in the wobble. Therefore, we are left with Miyamoto lacking the claimed spatial relationship of the wobble cycles in independent claim 1. Therefore, we cannot sustain the examiner's rejection of independent claim 1 and its dependent claims since the examiner has not established a ***prima facie*** case of anticipation by Miyamoto.

With respect to independent claim 11, the examiner relies upon the same portions of Miyamoto as with independent claim 1, but that the wobble cycles in the same zone subtend the same angle is "inherent" in Miyamoto as defined by appellant's definition of a Zone-CAV format. We find no such definition as the examiner asserts and do not find that Miyamoto teaches an in-phase alignment where the wobble cycles subtend the same angle within a zone and different zones subtend different angles each having the in-phase relationship. Therefore, we cannot sustain the examiner's rejection of independent claim 11 and its dependent claims since the examiner has not established a ***prima facie*** case of anticipation by Miyamoto.

35 U.S.C. § 103

With respect to dependent claim 2 and independent claim 19, the examiner adds the teachings of Aoki to teach and suggest the use of Bi-Phase Shift Keying (BPSK)-modulated wobble in the system of Miyamoto. (Answer at page 6.) We find no express teaching in Aoki of the use of BPSK modulation in the cited passage and no mention in the remainder of Aoki. Therefore, we agree with appellant that Aoki does not teach or suggest the use of BPSK modulation. Since we find no teaching of suggestion of the use of BPSK modulation, we similarly cannot agree with the examiner's motivation for the combination which is based upon the "reason(s) acknowledged by Aoki." (Answer at page 6.) Therefore, we find that the examiner has not established a ***prima facie***

case of obviousness of the claimed invention, and we will not sustain the rejection of independent claim 19 and its dependent claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4-8,10, 11, 13-18, and 21-25 under 35 U.S.C. § 102 is REVERSED, and the decision of the examiner to reject claims 2, 12, 19, 20, and 26 under 35 U.S.C. § 103 is REVERSED.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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LEE E. BARRETT) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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) INTERFERENCES
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